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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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4340261701 03/27/97 NOBUNU, MAI

6-311/01001

EXAMINER

748 JN

ART UNIT	PAPER NUMBER
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1546

DATE MAILED: 10/01/98

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/826,361

Applicant(s)
Mosselman et al.

Examiner
Michael Pak

Group Art Unit
1646



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 and 14-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-12 and 14-18 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The preliminary amendments filed 26 March 1997 (Paper No. 1.5), 3 July 1997 (Paper No. 5), and 16 October 1997 (Paper No. 10) have been entered. Claim 13 has been cancelled. Claims 1-12 and 14-18 are pending.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, 12, and 15-17, drawn to an isolated DNA, a recombinant expression vector, a cell, classified in Class 435, subclass 69.1.

II. Claims 9-11 and 18 drawn to a protein, classified in Class 530, subclass 350.

III. Claims 14, drawn to a method for identifying functional ligand, classified in Class 435, subclass 7.2.

The inventions are distinct, each from the other because of the following reasons.

The products of inventions I and II, are distinct each from the other, because they are drawn to products having materially different structures and functions.

Inventions I and II, and invention III, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of invention I can be used in DNA hybridization, while the product of invention II can be used to generate antibodies.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications and recognized divergent subject matter, and the search required for any one of inventions I-III is not required for any one of inventions I-III, restriction for examination purposes as indicated is proper.

A telephone call was made to Attorney Mary Gromley on 30 September 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must

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be accompanied by a filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

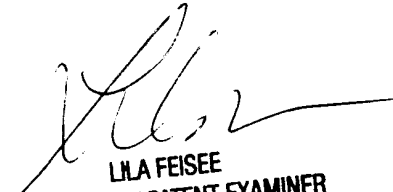
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

not

Michael D. Pak
1646
28 September 1998


LILA FEISEE
SUPERVISORY PATENT EXAMINER